

REMARKS

Claims 1-8 and 10 have been examined. Claims 3-8 have been rejected under 35 U.S.C. § 112, second paragraph, claims 1-8 and 10 have been rejected under 35 U.S.C. § 102(e), and claims 1-8 and 10 have been rejected under the judicially created doctrine of double patenting.

I. Preliminary Matters

The Examiner has not acknowledged the drawing filed on December 27, 2001. Accordingly, Applicant respectfully requests the Examiner to indicate, in the next Office Action, whether the drawing is acceptable.

Also, the Office Action Summary indicates that “none” of the priority documents have been received. The current Application, however, is a continuation of U.S. Application No. 09/340,675, in which a certified copy of the priority document was filed. Therefore, Applicant respectfully requests the Examiner to mark box 12(a)(2) on the next Office Action Summary (i.e. to indicate that the certified copy of the priority document was received in the parent Application).

In addition, the Examiner has returned the PTO 1449 form for the December 27, 2001 Information Disclosure Statement. However, the Examiner did not initial the foreign patent document, WO 9707641. Accordingly, Applicant is submitting herewith the partially initialed PTO 1449 form and respectfully requests the Examiner to initial the remaining document. The document that was not initialed has been circled.

Also, Applicant has made additional amendments to claims 3-8 for clarification purposes. Such amendments are not made in view of the prior art and do not narrow the scope of the claims.

II. Rejection under 35 U.S.C. § 112, second paragraph

Claims 3-8 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In particular, the Examiner maintains that “said access subnetwork,” of claims 3 and 7, lack antecedent basis. Accordingly, Applicant has amended claims 3 and 7 in a manner believed to overcome the rejection.

III. Rejection under 35 U.S.C. § 102(e) over U.S. Patent No. 6,393,482 to Rai et al. (“Rai”).

Claims 1-8 and 10 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Rai.

A. Claim 1

Applicant submits that claim 1 is patentable over the cited reference. For example, claim 1 recites a method of “providing, by a notifying service provider to said user, a notification which includes a capability to accept a service of an offered service provider different from a service of said notifying service provider.”

The Examiner cites to col. 7, lines 7-15; col. 8, line 53 - col. 9, line 50; col. 15, lines 31-61; and col. 16, lines 29-43, of Rai, as disclosing the features of claim 1. As set forth above, however, claim 1 recites that the notification accepts a service of an offered service provided which is different from a service of the notifying service provider. Based on the portions of Rai cited by the Examiner, the wireless services are the same whether using the user's home network (i.e. alleged notifying service provider) or the foreign network (i.e. alleged offered service provider). For example, when citing to the Rai reference, the Examiner maintains that, "the foreign network establishes communications with the subscriber's home network (wireless home service provider) in order to provide the subscriber with those services of the home service provider registered while its serving network is the foreign network" (pg. 3 of Office Action). In other words, even if a foreign network is used, the user is still provided with the services of the home service provider.

On the other hand, as disclosed on pg. 4 of the present Application, the non-limiting embodiments of the present invention do not have the drawback of the prior art, such that only the service of a home service provider is offered. A non-limiting embodiment of the present invention is also disclosed on pg. 6, where an offered service is hotel information. According to the prior art, only the hotel information of the home service provider is provided to the user, even if the user is in an area allocated to a different service provider. In the current invention, however, when a user is in a visited location, the user is able to obtain hotel information of the local hotels in the visited area (i.e. a service of an offered service provider different from a service of said notifying provider).

In view of the above, Applicant submits that Rai fails to teach or suggest every feature recited in claim 1. Accordingly, Applicant submits that claim 1 is patentable over the cited reference, and respectfully requests the Examiner to reconsider and withdraw the rejection.

B. Claim 2

Since claim 2 contain features that are analogous to the features recited above for claim 1, Applicant submits that claim 2 is patentable for at least analogous reasons as claim 1.

C. Claims 3-8

Since claims 3-8 are dependent upon claim 2, Applicant submits that such claims are patentable at least by virtue of their dependency.

D. Claim 10

Since claim 10 contain features that are analogous to the features recited above for claim 1, Applicant submits that claim 10 is patentable for at least analogous reasons as claim 1.

IV. Rejection under the Judicially created Doctrine of Double Patenting

Claims 1-8 and 10 have been rejected under the judicially created doctrine of double patenting over claims 1-9 of U.S. Patent No. 6,337,981 (i.e. parent Application to the current Application).

Amendment under 37 C.F.R. § 1.111
U.S. Application No. 10/026,768

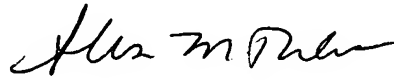
Applicants file herewith a Terminal Disclaimer, thereby overcoming the rejection of claims 1-8 and 10.

V. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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Substitute for form 1449 A & B/PTO

INFORMATION DISCLOSURE STATEMENT BY APPLICANT

(use as many sheets as necessary)

Sheet

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Complete if Known

Application Number	[case serial number]
Confirmation Number	Not Assigned
Filing Date	December 27, 2002
First Named Inventor	Marco Johannes Hubertus PETERS
Art Unit	Not Assigned
Examiner Name	Not Assigned
Attorney Docket Number	Q67918

U.S. PATENT DOCUMENTS

Examiner Initials*	Cite No. ¹	Document Number		Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document
		Number	Kind Code ² (if known)		
IQ		US 5,915,218		06/22/99	Talagery et al
IQ		US 5,930,714		07/27/99	Abu-Amara et al
		US			
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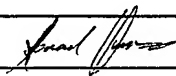
FOREIGN PATENT DOCUMENTS

Examiner Initials*	Cite No. ¹	Foreign Patent Document			Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Translation ⁶
		Country Code ³	Number ⁴	Kind Code ⁵ (if known)			
		WO	9707641		02/27/97	Northern Telecom Limited	Yes

OTHER PRIOR ART - NON PATENT LITERATURE DOCUMENTS

Examiner Initials*	Cite No. ¹	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city, and/or country where published.	Translation ⁶
IQ		European Telecommunication Standards Institute Standard, EMTS 22.70 version 3.0.0, TR 22.70 V3.0.0, March 1998, pp. 1-13	
IQ		G.P. Eleftheriadis et al, 'user Profile Identification in Future Mobile Telecommunications Systems', <i>IEEE Network</i> , September/October 1994, pp. 33-39	
IQ		R. Becher et al, 'CAMEL: The Impact of Personal Communications on Intelligent Networks, <i>ISS '97, XVI World Telecom Congress Proceedings</i> , Vol. 2, September 1997, pp. 225-233	
IQ		M. Torabi et al, "Third-Generation Mobile Telecommunications and Virtual Home Environment: A Prioritization Analysis", <i>Bell labs Technical Journal</i> , Vol. 3, No. 3, July-September 1998, pp. 50-62	

Examiner Signature



Date Considered

07/26/04

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

¹ Applicant's unique citation designation number (optional). ² See Kinds Codes of USPTO Patent Documents at www.uspto.gov, MPEP 901.04 or in the comment box of this document. ³ Enter Office that issued the document, by the two-letter code (WIPO Standard ST. 3). ⁴ For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. ⁵ Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. ⁶ Applicant is to indicate here if English language Translation is attached.